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Docket No.: 6195-0074-2

OBLON  
SPIVAK  
McCLELLAND  
MAIER  
&  
NEUSTADT  
P.C.

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/531,497  
Applicants: Yusuke NEMOTO  
Filing Date: March 21, 2000  
For: PRINTER  
Group Art Unit: 2854  
Examiner: Minh H. Chau

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SIR:

Attached hereto for filing is the following paper:

**PROVISIONAL ELECTION OF SPECIES  
REQUEST FOR EXTENSION OF TIME (1 MONTH)**

Our check in the amount of \$110.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted document, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the above-listed document timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

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Atty. Docket No. 6195-0074-2

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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

**IN RE APPLICATION OF**

**:**

**Yusuke NEMOTO**

**: GROUP ART UNIT: 2854**

**SERIAL NO: 09/531,497**

**:**

**FILED: March 21, 2000**

**: EXAMINER:**

**Minh H. Chau**

**FOR: PRINTER**

**:**

**PROVISIONAL ELECTION OF SPECIES**

**ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231**

**DEAR SIR:**

In response to the Election of Species requirement dated December 4, 2001, Applicants provisionally elect with traverse Species of Figure 1 as readable on Claims 2, 3, 10, 11 and 12.

Applicants respectfully traverse the election requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that "the application contains claims directed to ... patentably distinct species ..." without stating any basis whatsoever in support of such a finding. This is contrary to MPEP §816, which states:

**MPEP §816**

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. . . .

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

MPEP § 806.04(f)

Claims to be restricted to different species must be mutually exclusive. . .

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states:

MPEP § 803

... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicants also respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

In this particular case, since Applicants are at a loss as to the basis of the Election Requirement, in view of the fact that the Requirement does not state any analysis on how the species were decided, Applicants respectfully request that the requirement be withdrawn, or at the very least, that a new Official Action be mailed stating the basis for the Election.

Requirement and remedying the deficiencies above-noted, so that Applicants can then appropriately respond on the merits of the requirement.

Respectfully submitted,  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



**22850**

A handwritten signature in black ink, appearing to read "Gay Ann Spahn".

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